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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 669,477	09 25 2000	Peter Michael Murphy	CH2751 US NA	2960

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LEGAL PATENT RECORDS CENTER
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EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/07/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,477

Applicant(s)

MURPHY ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-13 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to a carpet underlay, classified in class 442, subclass 286+ and 394+.
 - II. Claim 14, drawn to a tufted carpet, classified in class 428, subclass 95.
 - III. Claim 15, drawn to carpet cushion, classified in class 442, subclass 221 and 370.
 - IV. Claims 16-18, drawn to a process for rendering carpet impermeable to liquids and permeable to vapor, classified in class 156, subclass 60+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as barrier fabric for garments or tarps and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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3. Inventions of Group I and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, the inventions have different effects in that the invention of Group I merely levels out a floor, while the invention of Group III adds cushion.

4. Inventions of Group I and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be employed as a protective cover for a vehicle or boat.

5. Inventions of Group III and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as floor mat or a protective cover and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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6. Inventions of Group IV and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process could be carried out by a single layer material of a liquid impervious, breathable film.

7. Inventions of Group III and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used as a protective cover for sharp edges corner or an exercise floor mat. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with George Medwick on September 27, 2002, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2002/0071944 A1 issued to Gardner et al.

Applicant claims a liquid impermeable, vapor permeable composite material of a nonwoven or woven fibrous substrate with a film fixed to said substrate. The substrate may be spun-laced (i.e., hydroentangled) polyester nonwoven, while the film may be a silicone rubber or polyurethane. With respect to Applicant's preamble limitation that the composite material is a carpet underlay, it is noted that said limitation is not given patentable weight at this time. A

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preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Additionally, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Gardner discloses a breathable barrier (i.e., liquid impermeable, vapor permeable) composite fabric (abstract). The fabric comprises a nonwoven web, such as a hydroentangled nonwoven, of fibers, such as polyester (sections [0020] and [0029]) and a film, which may be of a polyolefin, EVA, and acrylic acid copolymers (sections [0020] and [0033]). Thus, it can be seen that Gardner anticipates Applicant's claims 1-3.

12. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,100,208 issued to Brown et al.

Brown discloses an outdoor protective fabric comprising outer nonwoven webs sandwiched around a breathable barrier layer (abstract). The nonwovens may be hydroentangled webs (col. 9, lines 16-24) of bicomponent fibers having a sheath of polyolefin, polyester, or polyamide (col. 6, lines 56-67 and col. 7, lines 54-56). The breathable barrier layer has a

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moisture vapor transmission rate of at least 100 g/m^2 per day (col. 9, lines 42-50) and can be made out of polyolefins (col. 10, lines 21-22) or may be a breathable microporous film (US 4,194,041 issued to Gore et al. cited by Brown at col. 10, lines 31-34). The Gore film has a hydrophobic outer layer, such as expanded PTFE or polypropylene, and a hydrophilic inner layer, such as a polyurethane ether (Gore abstract, col. 4, lines 11-21, and col. 5, lines 7-23).

13. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,614,302 issued to Nance, Jr.

Nance teaches a protective garment comprising a woven fabric and a breathable barrier film (abstract). Nance also teaches it is known to make said protective garment of an SONTARA nonwoven fabric coated with a co-polyether-ester film, such a HYTREL (col. 5, lines 7-14 and lines 66-67).

Since Applicant teaches SONTARA as a spunlaced polyester fabric coated with HYTREL is particularly suited for the present invention (specification, page 4, line 31-page 5, line 17), it is argued that the cited Nance patent clearly anticipates claims 1-5.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Brown patent in view of US 5,614,302 issued to Nance, Jr.

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Brown does not explicitly teach the claimed butylene/poly(alkylene ether) phthalate copolymer film. However, such films are known in the art as being breathable barrier films. For example, Nance teaches a woven fabric coated with a breathable film, such as HYTREL, a butylene/poly(alkylene ether) phthalate copolymer film made by DuPont (col. 5, line 66-col. 6, line 11). Thus, it would have been obvious to substitute the HYTREL breathable film for the breathable film of the Brown invention, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore, claim 5 is rejected as being obvious over the cited prior art.

16. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Nance patent in view of the cited Brown patent.

Nance does not explicitly teach the claimed hydrophobic-hydrophilic bi-layer breathable film. However, as discussed above, Brown teaches Gore's bi-layer film. Thus, it would have been obvious to substitute the breathable film of Gore for the breathable film of the Nance disclosure, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore, claims 6 and 7 are rejected as being obvious over the cited prior art.

Claim Rejections - 35 USC § 102/103

17. Claim 8 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Gardner patent. Claim 8 is rejected under 35

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U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Nance.

Neither Gardner nor Nance explicitly teach the claimed MVTR. However, it is reasonable to presume that the inventions of Gardner and Nance inherently meet this limitation. Support for said presumption is found in the use of like materials (i.e., nonwoven material with a breathable film). The burden is upon Applicant to prove otherwise. In re Fitzgerald, 205 USPQ 495. In the alternative, the presently claimed MVTR would obviously have been present once the Gardner and Nance inventions were provided. *In re Best*, 195 USPQ 433.

Allowable Subject Matter

18. Claims 9-13 are allowed. The prior art does not teach a carpet underlay comprising a fibrous substrate, a tie layer, and a moisture vapor permeable, liquid impermeable film.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


20. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is 703-305-4472. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



CHEYL A. JUSKA
PRIMA EXAMINER